

ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

In the specification, the titles on the first page have been amended in response to the Examiner's objection.

Claims 1-15 remain in this application. Claims 4, 7 and 10 have been amended for the sole purpose of correcting spelling errors.

The Examiner objected to claims 4-12 for misspellings. The claims have been amended to make correct the error, making the objection moot.

Claims 1-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Admitted Prior Art (APA) found on pages 1-2 of the specification. For the following reasons, the rejection is respectfully traversed.

First, pages 1-2 of the specification discuss a background art. There is no admission that the materials are properly considered prior art under 35 U.S.C. §102. Accordingly, the material is not properly cited against the invention.

Second, claim 1 recites a step which "compares program size of the executable objects obtained by the linking processing step with the program size of a executable objects stored in a storing section every time when the linking order is changed". The Examiner cites page 2, lines 5-11 as teaching the cited claim limitations. However, the cited passage does not support the Examiner's assertion.

There is no teaching or suggestion in the cited passage for comparing with an executable object that is stored in a storing section. In fact, there is no discussion at all of a storing section. Thus, claim 1 is patentable over the alleged APA for at least that reason.

Claim 1 also recites a storing step for "storing the program size of the executable objects and the linking order obtained by the linking processing step in the storing section to

update when the program size of the executable objects obtained by the linking processing step is smaller than the program size of the executable objects stored in the storing section at the comparing step". As discussed above, there is no suggestion in the section cited by the Examiner of any storing section. Thus, claim 1 is also patentable over the alleged APA for that reason as well.

Claims 2-3, which depend, directly or indirectly, on claim 1, are thus patentable over the alleged APA for at least the same reasons.

Furthermore, claim 2 recites that "the intermediate object linking order forming step decides the linking orders by a permutation algorithm" and claim 3 recites that the intermediate object linking order forming step "decides the linking orders by a genetic algorithm". The Examiner admits that the alleged APA does not teach such algorithms, but takes official notice that such algorithms are known, and states that adding that feature to the APA would be "obvious" in order to prepare a new link order for the system of the APA.

First, applicant traverses the Examiner's Official Notice. Taking "official notice" requires that facts outside of the record be capable of instant and unquestionable demonstration as being 'well-known' *in the art* (see MPEP §2144.03). However, applicant assumes that the Examiner has attempted, but failed, to find a reference which teaches the cited elements of the claims. Hence, these elements are not likely to be "notoriously well known" in the art, as required. Accordingly, applicant hereby traverses the official notice and formally requests, as required by the MPEP (*id.*), that the Examiner locate a reference *in the applicable art* in support of his position.

Furthermore, the Examiner has not provided legally proper motivation for modifying the alleged APA. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP §2142). To support a *prima facie* case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish *prima facie* obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish *prima facie* obviousness (*Id.*).

However, such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph). In this case, the Examiner cites the application itself for the prior art. Thus, any motivation obtained from the application would be improper hindsight motivation. Merely listing an advantage or benefit of the combination is not sufficient, as some *rationale* for combining the references must be found in the references themselves, or drawn from a *convincing line of reasoning based on established scientific principles practiced by one skilled in the art* that some advantage or beneficial result would be produced by the combination (MPEP §2144).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘*as a whole*’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn. Consequently, claims 2 and 3 are patentable over the alleged APA.

Claim 4 recites a storing section, and thus is patentable over the alleged APA for the corresponding reasons discussed for claim 1.

Furthermore, claim 4 recites that “the storing section stores the program size of the executable objects and the linking order formed by the linker starting section when the program size of the executable objects formed by the linker starting section is smaller than the program size of the executable objects stored in the storing section at the comparison by the comparing section”. There is no suggestion of any storing section in the alleged APA, and there is accordingly no suggestion of storing according to the cited criteria. Thus, claim 4 is patentable over the alleged APA.

Claims 5-6, which depend on claim 4, are thus patentable over the alleged APA for at least the same reasons as claim 4. Furthermore, claim 5 has similar limitations as claim 2, and claim 6 has similar limitations as claim 3, and thus each are further patentable over the

alleged APA for the same reasons discussed for claims 2 and 3, above.

The remaining claims 7-15 each has one or more limitations similar to those discussed above, and thus are patentable over the alleged APA for at least the same reasons.

Claims 1-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Smaalders *et al.* (U.S. 5,790,865). For the following reasons, the rejection is respectfully traversed.

As discussed above, claim 1 recites a

comparing step which compares program size of the executable objects obtained by the linking processing step with the program size of a executable objects stored in a storing section every time when the linking order is changed;

Claim 13 recites similar limitations at lines 13-17.

The Examiner admits that the cited reference does not teach such a comparing step. Instead, the Examiner states that it was known to “work toward smaller code” and that it would then be obvious to add the comparing step of the invention to Smaalders. Thus, the Examiner appears to be arguing that, because the result of the method of the invention may be known or desired, that the method would be obvious. Applicant strongly disputes that this is a proper rejection.

The Examiner is reminded that claims 1 and 13 recite a process/method. As such, the burden is on the Examiner to show that the method is either known in the art, or legally obvious. It is not relevant that the method/process may share a common goal or benefit with another method/process or device. The Examiner is required to show that the process itself is known or obvious. This the Examiner has failed to do.

There is nothing in the Smaalders reference that suggests the comparing step. Instead, Smaalders teaches a method whereby software code sections are monitored for frequency of access/execution, and the code rearranged based on that access (see col. 2, line 61 to col. 3, line 11). Although such code rearrangement may, in some circumstances, result in more efficient use of memory, there is nothing in the reference that suggests the comparing step of claims 1 and 13. Accordingly, claims 1 and 13 are patentable over the reference.

In addition, claim 1 recites the step of:

a storing step for storing the program size of the executable objects and the linking order obtained by the linking processing step in the storing section to update when the program size of the executable objects obtained by the linking processing step is smaller, than the program size of the executable objects stored in the storing section at the comparing step;

Yet again, there is no teaching or suggestion in the reference for storing the program size. Therefore, claims 1 and 13 are patentable over the reference for this reason as well.

Claims 2-3 and 14-15, which depend, respectively, upon claims 1 and 13, are thus patentable over the references for the same reason as the parent claims.

Furthermore, as discussed above, claims 2-3 and 14-15 recite the use of specific algorithms that are not suggested by the reference. The Examiner admits as much, but takes Official Notice that these algorithms are known. Again, applicant disputes that the use of such algorithms in the pertinent art are well known, and requests that the Examiner provide documentary evidence of this.

Claims 4, 7, and 10 recite structure(s) that perform the method steps cited for claims 1 and 13, above. The reference fails to teach either the method steps, or structure for performing the method steps. Accordingly, claims 4, 7, and 10 are patentable over the reference. The remaining claims depend on one of claims 4, 7, and 10, and thus are also patentable over the reference for at least the same reason as their parent claim. Furthermore, these claims also contain limitations similar to one of claims 2 and 3, and thus are patentable over the reference for the same reasons as claims 2 or 3 as well.

Finally, yet again, the Examiner has failed to provide the proper motivation for modifying the reference as suggested in the Office action. In fact, because the Examiner argues that the reference already teaches a method of reducing code size, there can hardly be any motivation for pursuing the totally different such method taught by the invention. Applying the method of the invention would change the principle of operation of the Smaalders device, and that is not permissible, because the proposed modification cannot render the prior art unsatisfactory for its intended purpose, or change the principle of operation of a reference (MPEP §2143.01). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125. Thus, the rejections for obviousness are not proper and should be

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withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33587.

Respectfully submitted,

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